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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Chang et al	)	Examiner: C. Fronda
S/N: 09/551,380	)	Art Unit: 1652
Filed: 04/18/2000	)	Conf. No.: 2514
Title: "Modified Fluorescent Proteins for Detecting Protease Activity"	)	

RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

Commissioner for Patents  
Washington, DC 20231

Dear Sir:

This is in response to the Restriction Requirement of 7/18/01. Applicant was given a one-month period in which to respond. Applicant respectfully submits this response is filed within the one-month statutory period.

Applicant notes the Examiner's comments directed to the nucleotide and amino acid sequences and requirements for sequence listing. By way of a separate Preliminary Amendment, Applicant is filing a response to the sequence listing request.

For the reasons set forth below, Applicant respectfully submits that a new election/restriction requirement needs to be forthcoming from the Examiner. Solely for the purposes of complying with the response rules, Applicant elects with traverse Group I which corresponds to claims 1 through 7, 25, and 26 directed to a fluorescent protein classified in class 530, subclass 350. With respect to claims 5 and 6, Applicant elects with traverse the disclosed species D9. With respect to claim 7, Applicant elects with traverse species corresponding to Seq. ID No. 4.

Applicant believes the above restriction/election requirement is traversed for multiple grounds. Foremost, the Examiner has made an initial restriction requirement directed to Groups I through XI. However, the written information provided for the restriction requirement does not provide adequate explanation for the various

groupings. For instance, Groups III and IV are both directed to the identical class and subclass. As such, it is difficult to reconcile the identical classification for groupings that are held to be different inventions.

A similar grounds of traversal is made with respect to the initial grouping of V and VI as both being in class 435, subclass 23. Again, the identical class and subclass designations for these claim groupings would suggest that there is no *prima facie* case of multiple inventions for which restriction should be required.

For the same grounds, Groups VII and VIII are both directed to class 435, subclass 7.72. Applicant respectfully submits that the restriction requirement is improper if, indeed, the Examiner is asserting the identical class and subclass for groupings VII and VIII.

Groups IX through XI are all directed to the identical classification of class 435, subclass 23. As such, the basis for a three-way restriction with respect to the identical class and subclass appears to be in error.

In light of the above confusion with respect to the grouping of the claims, Applicant respectfully submits that a new restriction requirement is needed so as to establish exactly which claims are properly restricted and into which groups. Further, upon receipt of a new restriction/election requirement, Applicant reserves the right to change the initial restriction and election requirement since different groupings of claims may alter Applicant's above response with traverse.

More specifically, Applicant respectfully submits that the species requirement is inappropriate for claim 6. Claim 6 is a dependent claim in which the subject matter is to a grouping of various colored fluorescent proteins which are commercially available and/or described in the literature. To the extent that claim 6 is a Markush grouping of various known fluorescent proteins of different colors, a species requirement seems inappropriate.

Applicant also disagrees with the restriction requirement with respect to Groups I and II. The Examiner stated that the polypeptide of Group I and the polynucleotide of Group II are independent chemical entities and require different literature searches. Applicant respectfully submits that the corresponding polynucleotides and polypeptides

are sufficiently interlinked that different literature searches are not required. For instance, Applicant directs the Examiner's attention to US Patent No. 5,981,200 that is directed to the same field of invention as Applicant's Group I and Group II claims. As noted on the face of the '200 patent, the claims of the single patent fall within ten different groupings of classes and subclass combinations. Further, it should be noted that class 530, subclass 350 of Group I and class 435, subclass 252.3 of Group II all fall within the field of search in technology of this sort. As such, Applicant respectfully submits that the Examiner's assertion that the inventions of Group I and Group II are independent and require different literature searches is not supported by either the art or the USPTO practice with respect to inventions of this type.

For similar reasons, Applicant respectfully submits that the invention of Group I is not unrelated to the initial invention grouping of Groups III and IV. Again, the cited reference clearly indicates that the relevant classes and subclasses may be found within a single field of search for inventions of this type. Accordingly, Applicant respectfully submits that the initial groupings of I through IV are sufficiently related so as not to require different literature searches.

Further, the initial groupings of Groups VII and VIII directed to class 435, subclass 7.72 would also appear to fall within a sufficiently narrow field of search so as to traverse any restriction requirement with respect to Group I, Group II, Group III, or Group IV. Applicant also notes that as a separate ground of traversal, the first election/restriction requirement provides no basis for distinguishing between Groups IV through Groups XI. Rather, the restriction requirement only addresses the different groupings with respect to Group I, Group II, and Group III.

In light of this, Applicant respectfully requests a reconsideration of the prior restriction requirement along with an opportunity to respond thereto. While Applicant has made an election with traverse as required by 37 CFR 1.143, Applicant believes a more proper restriction requirement is needed. In light of this, Applicant is not canceling any claims at this time.

The Examiner is encouraged to contact the undersigned should there be any questions regarding the present response.

Respectfully submitted,  
DORITY & MANNING, PA

A handwritten signature in black ink, appearing to read "J. B. Mullinax". The signature is fluid and cursive, with the first name "J. B." and the last name "Mullinax" clearly distinguishable.

J. Bennett Mullinax

Reg. No. 36,221